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OFFICE OF PETITIONS

In re Application of :
Palese, et al :
Application No. 09/396,539 :
Filed: 14 September, 1999 :
Attorney Docket No. 26-003700US :

ON PETITION

This is a decision on the petition filed on 2 May, 2005, under 37 C.F.R. §1.48, requesting correction of the inventorship of the application, and for authority to prosecute the application with a non-signing inventor under 37 C.F.R. §1.47—but more properly considered as a waiver under 37 C.F.R. §1.183 of the requirements of 37 C.F.R. §1.67 for a supplemental oath.

For the reasons set forth below the petition under:

- the petition under 37 C.F.R. §1.48 is **DISMISSED**;
- the consideration of the matter as a request for waiver under 37 C.F.R. §1.183 of the 37 C.F.R. §1.67 is **DISMISSED** and as authorized the fee is charged to Deposit Account 50-0893; and
- the petition under 37 C.F.R. §1.47 is **DISMISSED**.

BACKGROUND

Accompanying the 2 May, 2005 petition under 37 C.F.R. §1.48(a) and/or §1.47 are:

- the declarations of Jeffrey D. Parvin and Mark Krystal that their names were excluded in error in the application data sheet; the error was without deceptive intent;
- the statements by Paul Littlepage (Reg. No. 48,581) and Jonathan Klein-Evans (Mr. Klein-Evans) as to their discussions with non-signing inventor Peter Palese (Dr. Palese) and/or his legal representatives and to the basis for deleting Adolpho Garcia-Sastre from the inventive entity;
- a certificate under 37 C.F.R. §3.73(b) attesting to the assignment lineage of the instant application and the statement by Mr. Klein-Evans as to the agreement by the assignee (100 percent interest) as to the requested changes in the inventive entity;
- evidence of the attempt (made in the context of 37 C.F.R. §1.47 but more appropriately considered herein as a request for waiver under 37 C.F.R. §1.183 of the provisions of 37 C.F.R. §1.67) to contact Dr. Palese and present him with a copy of the entire application (specification and drawings) along with a copy of the supplemental oath/declaration and obtain his signature and that he has failed to comply.

Notably, Office records reflect that Application No. 09/396,539 issued as Patent No. 6,887,699 on 3 May, 2005—a day after the instant petition was filed.

That event placed the instant matter under the statutory control of 35 U.S.C. 256:

35 U.S.C. 256 Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.¹

¹ Amended Aug. 27, 1982, Public Law 97-247, sec. 6(b), 96 Stat. 320; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).

As indicated at the commentary at MPEP §1481:

The statutory basis for correction of inventorship in a patent under 37 C.F.R. §1.324 is 35 U.S.C. §256. It is important to recognize that 35 U.S.C. §256 is stricter than 35 U.S.C. §116, the statutory basis for corrections of inventorship in applications under 37 C.F.R. §1.48. 35 U.S.C. §256 requires “on application of all the parties and assignees,” while 35 U.S.C. §116 does not have the same requirement. Under 35 U.S.C. §116 and 37 C.F.R. §1.48, waiver requests under 37 C.F.R. 1.183 may be submitted (see, e.g., MPEP §201.03, under the heading “Statement of Lack of Deceptive Intention”). This is not possible under 35 U.S.C. §256 and 37 C.F.R. §1.324. In correction of inventorship in a nonprovisional application under 37 C.F.R. §1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 C.F.R. §1.183; however, correction of inventorship in a patent under 37 C.F.R. §1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. §256) and thus the requirement cannot be waived.

Accordingly, the petition under (or considered under) 37 C.F.R. §1.47, §1.148 and the §1.183 waiver of §1.67 hereby is **dismissed**.

The application is released to Files Repository.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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